



Appendix B

AMENDMENT UNDER 37 C.F.R. 1.116

EXPEDITED PROCEDURE

EXAMINING GROUP 3628

PATENT

Serial No. 09/650,733

Attorney Docket No. 1011-002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Alejandro M. Pilato

Serial No. : 09/650,733

Filed : 30 August 2000

For : METHOD AND SYSTEM FOR PROVIDING FINANCIAL
FUNCTIONS

Art Unit : 3628

Examiner : Richard C. Fults

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

DECLARATION UNDER 37 C.F.R. § 1.132

Sir:

I, William W. Sihler, a citizen of the United States, whose full post office address is 3215 Heathcote Lane, Keswick, VA 22947 declare as follows under penalty of perjury.

1. I hold a Doctors in Business Administration from Harvard University awarded in 1965.
2. I hold a Master of Business Administration from Harvard University awarded in 1962.
3. I hold a A.B. degree in Government from Harvard University awarded in 1959.
4. I am currently the Ronald Edward Trzcinski Professor of Business Administration at the University of Virginia.

AMENDMENT UNDER 37 C.F.R. 1.116

EXPEDITED PROCEDURE

EXAMINING GROUP 3628

PATENT

Serial No. 09/650,733

Attorney Docket No. 1011-002

5. Since 1965, I have worked continually in the field of Business Administration with particular emphasis in financial management and financial services.
6. I have reviewed Application Serial No. 09/650,733.
7. I have reviewed U.S. Patents Nos. 5,644,727 (Atkins); and 6,021,397 (Jones).
8. Among the systems and methods with which I was familiar prior to 30 August 2000, the filing date of Application Serial No. 09/650,733, were systems and methods of the type recited in Atkins and Jones.
9. I have reviewed the U.S. Patent Office Action dated 8 March 2004 ("Office Action 2") in Application Serial No. 09/650,733, which contains the following statement: "While Atkins does not explicitly teach an agent, it would have been obvious to one skilled in the art at the time of the invention that an agent is simply a representative of the principal...."
10. That statement is factually incorrect, in view of the state of the financial services art as of 30 August 2000, the filing date of Application Serial No. 09/650,733. It would not have been obvious to one skilled in the art at the time of the invention that the term "agent", as used in Application Serial No. 09/650,733, "is simply a representative of the principal".
11. Rather, one skilled in the art would interpret the term "agent" to mean a "financial risk manager", as explicitly defined at line 12 on page 10 of Application Serial No. 09/650,733.

AMENDMENT UNDER 37 C.F.R. 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 3628
PATENT
Serial No. 09/650,733

Attorney Docket No. 1011-002

12. Moreover, one skilled in the art would instantly recognize the term “financial risk manager”, as one at whom are directed books such as *Managing Financial Risk: A Guide to Derivative Products, Financial Engineering, and Value Maximization*, by Charles W. Smithson, Publisher: McGraw-Hill Trade; 3rd edition (June 30, 1998), ISBN: 007059354X (see back cover “for years, financial executives and risk managers have recognized Charles Smithson's *Managing Financial Risk* as the authoritative source for comprehensive coverage of risk management products.”)
13. Accordingly, one skilled in the art would not find that Atkins teaches or suggests an “agent” as that term is defined in Application Serial No. 09/650,733.
14. Moreover, one skilled in the art would find that Atkins makes no provision for an “agent” as that term is defined in Application Serial No. 09/650,733.
15. Further, one skilled in the art would not find that Jones teaches or suggests an “agent” as that term is defined in Application Serial No. 09/650,733.
16. Office Action 2 contains the following statement: “...the words ‘institutional or corporate’ are merely an intended use....”
17. That statement is factually incorrect, in view of the state of the financial services art as of 30 August 2000, the filing date of Application Serial No. 09/650,733.
18. Rather, one skilled in the art would interpret the words “institutional or corporate” as used in Application Serial No. 09/650,733 to be required limitations of each of claims 1-

AMENDMENT UNDER 37 C.F.R. 1.116

EXPEDITED PROCEDURE

EXAMINING GROUP 3628

PATENT

Serial No. 09/650,733

Attorney Docket No. 1011-002

139, and to define the type of “client” cited in those claims.

19. Moreover, one skilled in the art would not find that either Atkins or Jones teaches an “institutional or corporate client”.
20. Rather, Atkins allegedly recites a “a method and apparatus for effecting an improved **personal** financial analysis, planning and management system...”. See “Summary of the Invention” at col. 7, lines 19-21.
21. One skilled in the art would not equate a “**personal** financial analysis, planning and management system” with a “financial system” used for servicing the needs of an “institutional or corporate” client.
22. Accordingly, one skilled in the art would not find that Atkins teaches an “institutional or corporate client”.
23. Further, Jones allegedly recites that “[i]n view of the foregoing, what is needed is a financial advisory system that employs advanced financial techniques to provide financial advice to **individuals** on how to reach specific financial goals.” See col. 2, lines 13-17. The “specific advice” provided to the user of Jones regards “steps they can take to improve their chances of meeting their financial goals while taking into consideration the user’s personal tradeoffs among risk, savings, and retirement age.” See col. 2, lines 40-45.
24. One skilled in the art would not equate “financial techniques to provide financial advice to **individuals**... while taking into consideration... personal tradeoffs among risk,

AMENDMENT UNDER 37 C.F.R. 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 3628
PATENT
Serial No. 09/650,733
Attorney Docket No. 1011-002

savings, and retirement age" with "financial techniques" used for servicing the needs of an "institutional or corporate" client.

25. Accordingly, one skilled in the art would not find that Jones teaches or suggests an "institutional or corporate client".
26. Office Action 2 contains the following statement: "Atkins explicitly discloses (see columns 1-80)... receiving financial information at the agent". That statement is factually incorrect, in view of the state of the financial services art as of 30 August 2000, the filing date of Application Serial No. 09/650,733.
27. Rather, one skilled in the art would not find that Atkins teaches or suggests "receiving financial information at the agent" or "receiving financial information at a computer of the agent", because, at a minimum, Atkins does not teach or suggest an "agent" as defined in Application Serial No. 09/650,733.
28. Likewise, one skilled in the art would not find that Jones teaches or suggests "receiving financial information at the agent" or "receiving financial information at a computer of the agent", because, at a minimum, Jones does not teach or suggest an "agent" as defined in Application Serial No. 09/650,733.
29. Office Action 2 contains the following statement: "Atkins explicitly discloses (see columns 1-80)... demonstrating to the client the potential transparency of activities of the agent...."

AMENDMENT UNDER 37 C.F.R. 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 3628
PATENT
Serial No. 09/650,733
Attorney Docket No. 1011-002

30. That statement is factually incorrect, in view of the state of the financial services art as of 30 August 2000, the filing date of Application Serial No. 09/650,733.
31. Rather, one skilled in the art would not find that Atkins teaches or suggests “demonstrating to the client the potential transparency of activities of the agent....” Moreover, consistent with the statement at the bottom of the first partial paragraph on page 3 of Office Action 2, one skilled in the art would not find that Atkins teaches or suggests “transparency” or “transparency of activities of the agent” as those terms are used in Application Serial No. 09/650,733.
32. Office Action 2 contains the following statement: “Jones teaches (see columns 1-24) the transparency of financial activities to the client....”
33. Although the phrase “the transparency of financial activities to the client” does not appear in any claim of the application, that statement is nonetheless factually incorrect, in view of the state of the financial services art as of 30 August 2000, the filing date of Application Serial No. 09/650,733.
34. Rather, as one skilled in the art would interpret the term “transparency” as that term is used in Application Serial No. 09/650,733, Jones makes no mention of either the term “transparency” or the concept underlying the term “transparency”.
35. Accordingly, one skilled in the art would not find that Jones teaches or suggests “demonstrating to the client the potential transparency of activities of the agent....”,

AMENDMENT UNDER 37 C.F.R. 1.116

EXPEDITED PROCEDURE

EXAMINING GROUP 3628

PATENT

Serial No. 09/650,733

Attorney Docket No. 1011-002

“transparency of activities of the agent”, or “transparency” as those terms are used in Application Serial No. 09/650,733.

36. Office Action 2 contains the following statement: “Atkins explicitly discloses (see columns 1-80)... enabling the agent to determine an action based on the analysis of risk management information created from the financial information.”
37. That statement is factually incorrect, in view of the state of the financial services art as of 30 August 2000, the filing date of Application Serial No. 09/650,733.
38. Rather, one skilled in the art would not find that Atkins teaches or suggests “enabling the agent to determine an action based on an analysis of risk management information created from the financial information”, because, at a minimum, Atkins does not teach or suggest an “agent” as defined in Application Serial No. 09/650,733.
39. Similarly, one skilled in the art would not find that Jones teaches or suggests “enabling the agent to determine an action based on an analysis of risk management information created from the financial information”, because, at a minimum, Jones does not teach or suggest an “agent” as defined in Application Serial No. 09/650,733.
40. Office Action 2 contains the following statement: “Atkins explicitly discloses (see columns 1-80)... enabling the client to monitor through a network activities of the agent....”
41. That statement is factually incorrect, in view of the state of the financial services art as of

AMENDMENT UNDER 37 C.F.R. 1.116

EXPEDITED PROCEDURE

EXAMINING GROUP 3628

PATENT

Serial No. 09/650,733

Attorney Docket No. 1011-002

30 August 2000, the filing date of Application Serial No. 09/650,733.

42. Rather, one skilled in the art would not find that Atkins teaches or suggests “enabling the client to monitor through a network activities of the agent....”
43. Similarly, one skilled in the art would not find that Jones teaches or suggests “enabling the client to monitor through a network activities of the agent....”
44. Office Action 2 contains the following statement: “[t]here is no difference in the functions performed or how they are performed.”
45. That statement is factually incorrect, in view of the state of the financial services art as of 30 August 2000, the filing date of Application Serial No. 09/650,733.
46. Rather, due to the challenges of building the client’s trust in the agent, one skilled in the art would recognize the substantial difficulties in outsourcing financial functions and that Application Serial No. 09/650,733 teaches one or more novel and non-obvious methods, systems, and devices for overcoming those difficulties.
47. Further, one skilled in the art would not find that either Atkins or Jones teaches those substantial difficulties or any of the claimed novel and non-obvious methods, systems, or devices for overcoming them.

I further declare that all statements made herein of my own knowledge are true and that these statements were made with the knowledge that willful false statements and the like so made are



AMENDMENT UNDER 37 C.F.R. 1.116

EXPEDITED PROCEDURE

EXAMINING GROUP 3628

PATENT

Serial No. 09/650,733

Attorney Docket No. 1011-002

punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States

Code and that willful false statements may jeopardize the validity of the application or any patent
issuing thereon.

Signed this 5th day of Oct 2004

William W. Sihler

Dr. William W. Sihler